

REMARKS

The Examiner's communication dated June 28, 2005 has been received and carefully considered. In conformance with the applicable statutory requirements, this paper constitutes a complete reply and/or a bona fide attempt to advance the application to allowance. In particular, detailed arguments supporting the patentability of all claims (i.e., claims 1-22) are included. Reexamination and/or reconsideration of the application as amended are respectfully requested.

Summary of the Office Action

Claims 1-22 still stand rejected under 35 U.S.C. § 103(a) as being unpatentable over "Admitted Prior Art hereinafter" [sic] APA (fig. 1 of the application) in view of Yamada et al." (U.S. Patent No. 4,827,897).

Finality of Office Action?

The Office Action to which this paper is responsive (i.e., the Office Action mailed on June 28, 2005) is ambiguous as to whether the Office Action is a final Office Action or a non-final Office Action. In particular, page 1 of the Office Action indicates that the action is non-final, but page 4 of the Office Action indicates that the action is final. Thus, it is entirely unclear to Applicant whether the Office Action of June 28, 2005 is a final or non-final Office Action. Clarification is requested. Moreover, Applicant submits that the June 28 Office Action should be deemed non-final due to this ambiguity.

Notwithstanding the foregoing, Applicant respectfully asserts that the Office Action of June 28, 2005 cannot properly be made a final Office Action. In the first Office Action of January 26, 2005, the Examiner failed to give claims 2-22 more than a cursory review. As discussed at length in the previous paper entitled "Amendment" submitted by Applicant in response to this initial Office Action, the Examiner summarily dealt with twenty-one (21) claims, i.e., claims 2-22, in a single conclusory sentence. In the present Office Action to which this paper is responsive, the Examiner has merely repeated the single sentence rejection from the earlier Office Action. Thus, to date, the Examiner has not fully and fairly applied the references of record to claims 2-22.

In particular, the single sentence included in both Office Actions to date is as follows: "Regarding claims 2-22, the proposal in combination of the APA and Yamada et al. disclose all the aspect [sic] of the claimed invention." Per MPEP § 706.07 dealing

with final rejections, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied. The single sentence rejection of the Office Action can hardly be said to fully apply the references. Further, the same section of the MPEP states that "[t]he examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. The Examiner, by not fully applying the references to any of claims 2-22, has failed to provide Applicant a full and fair hearing on these claims.

Conveniently, the Examiner entirely ignored Applicant's arguments with respect to claims 2-22, including the arguments concerning the lack of detailed treatment of these claims and the arguments asserting that the Examiner has failed to present a *prima facia* case of obviousness in rejecting these claims. For all the foregoing reasons, Applicant again requests that the § 103 rejection concerning claims 2-22 be withdrawn or, at a minimum, the Examiner provide specific arguments supporting his position as to why each of claims 2-22 stands rejected. As before, Applicant continues to assert that any continued rejection of any one of claims 2-22 should not be made final because, to date, Applicant has not been given a fair opportunity to respond to the Examiner's rejections of these claims as no detailed and/or clearly articulated reasons have yet been provided with the rejections of these claims.

The Claims Distinguish Patentability
Over the Reference(s) of Record

1. Claim 1

In Applicant's previous submission (responsive to the initial Office Action), it was submitted that the combination of art applied by the Examiner against claim 1 was improper. Particularly, Applicant asserted, and continues to assert, that the combined art was nonanalogous and motivation to combine was lacking. The Examiner attempted to rebut Applicant's arguments by asserting, first, that the applied references (i.e., Figure 1 of Applicant's application and the Yamada reference) are in analogous arts because the fields of endeavor of both are "in same field motor structure, specifically in brushes arrangement" and, second, that there is some teaching, suggestion or motivation to combine the applied references found "in the knowledge generally available to one of ordinary skill in the art." Office Action at pg. 2 citing *In re Fine*, 837 F.2d 1071 (Fed Cir. 1988) and *In re Jones*, 958 F.2d 347 (Fed. Cir. 1992).

Per the Examiner, "the record is clearly shown by combined the two cited references, and regarding motivation is support a phase underlined above. [sic]" *Id.*

A. Nonanalogous Art

Applicant continues to assert that Figure 1 of the instant application (referred to as "Admitted Prior Art" by the Examiner) and Yamada et al. are directed toward nonanalogous art. As stated in Applicant's previously submitted Amendment, Figure 1 relates to a wire feeder for an electric arc welder having a set of feed rolls driven by a DC motor. In contrast, Yamada et al. relates to a fuel pump driving apparatus which is used with an engine including a fuel injection system (Col. 1, lines 5-7). Applicant asserts that the fields of endeavor of FIGURE 1 and Yamada et al. are entirely distinct and not likely to be cross-referenced by applicants or those skilled in the art practicing in one or the other of the two fields of endeavor. Moreover, Applicant asserts that one skilled in the art would not look toward a fuel pump driving apparatus to improve the drive system of a wire feeder for an electric arc welder.

Applicant further asserts, in reply to the Examiner's response to Applicant's previously submitted arguments, that the fields of endeavor of the applied references cannot merely be said to be "motor structure, specifically in brushes arrangement." Applicant is not merely claiming a motor structure. Rather, Applicant is claiming a wire feeder for an electric arc welder that employs a DC motor with a third brush. In contrast, Yamada et al. is in the field of fuel pumps (and is primarily classified under a fuel pump subclass for an internal combustion engine). Applicant continues to assert that these fields are nonanalogous.

B. Motivation to Combine References Missing

Applicant continues to assert that one skilled in the art would not be motivated to combine Figure 1 of Applicant's application with Yamada et al. In response to Applicant's contention that the Examiner has failed to provide a reference or other evidence to support his conclusion that it would be obvious to one skilled in the art to modify the teachings of FIGURE 1 with the teachings of Yamada et al., the Examiner appears to indicate that motivation to combine the references is "In the knowledge generally available to one of ordinary skill in the art." Office Action at pg. 2. The Examiner cites *In re Fine* and *In re Jones* in support of this statement. Perhaps

ominous to the Examiners position, a review of these cases reveals that, in both cases, the Court determined that motivation to combine references was lacking.

More importantly, merely stating that motivation to combine is in the knowledge available to one of ordinary skill in the art is insufficient to support a *prima facie* case of obviousness. As stated in Applicant's previous submission, simply because the wire feeder shown in Figure 1 could be modified to include the fuel pump driving apparatus of Yamada et al., motivation to modify and/or combine the teachings of FIGURE 1 and Yamada et al. is not found. In particular, according to MPEP § 2144.01, the "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness." Just because the claimed elements are individually found in the prior art, it does not necessarily follow that it would be obvious to combine the elements from different prior art references. See MPEP § 2141.01 *citing Ex parte Levengood*, 28 USPQ 2d 1300 (Bd. Pat. App. & Inter. 1993). Consequently, absent a motivation to combine and modify, it is irrelevant that the elements and/or limitations may be individually or separately known in the prior art.

The Examiner is combining these references for no other reason than to arrive at the invention of claim 1. In the face of Applicant's challenge to the Examiner's rejection, the Examiner is attempting to ignore the simple fact that he has presented no evidence as to why one skilled in the art would be motivated to combine the teachings of the applied references. Merely because the Examiner says motivation to combine is found in the knowledge generally available to one of ordinary skill in the art does not make it so. Without more, the Examiner has not met his burden to show why claim 1 is obvious. Accordingly, for at least these reasons, Applicant asserts that claim 1 and claims 2-17 dependent therefrom distinguish patentably over the references of record.

II. Claims 2-22

As already discussed above and in Applicant's previous response to the Examiner's initial Office Action, the Examiner has yet, despite issuing two Office Actions on the merits, to fully examine claims 2-22 of Applicant's application. In the second Office Action to which this paper is responsive, the Examiner merely parrots his earlier statement, typographical errors and all. The statement is entirely conclusory and does not specify how the Examiner is applying the references of record to each of claims 2-22, let alone to each of the limitations contained in these claims.

Applicant continues to assert that the Examiner has not met his burden necessary for rejecting claims 2-22 as obvious. Merely stating that the references of record disclose all aspects of the claimed invention is not enough to support an obviousness rejection. Firstly, each of claims 2-22 includes a claimed invention and each of these claims should be examined on its own merits. Secondly, to establish a *prima facie* case of obviousness, the Examiner must show three basic criteria: motivation to combine the references, a reasonable expectation of success and a teaching or suggestion of each of the claim limitations. *Id.* The Examiner has not made such a showing for any of claims 2-22. Accordingly, Applicant submits that the Examiner's rejections concerning these claims must be withdrawn.

In particular, claim 2 calls for the switch circuit of claim 1 to be manually operated. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 2 distinguishes patentably over the references of record.

Claim 3 calls for the wire feeder of claim 1 to include a controller with a first output signal causing the switch circuit to select the second brush and a second signal causing the switch circuit to select the third brush. Applicant does not find these limitations in either of the applied references. Moreover, the Examiner has not pointed out with specificity where these limitations are disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 3 distinguishes patentably over the references of record.

Claim 4 calls for the controller output signal of claim 3 to be caused by an input signal indicative of wire size. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 4 distinguishes patentably over the references of record.

Claim 5 calls for the wire feeder of claim 4 to include a fixed ratio gear reducer between the motor and the feed rolls. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 5 distinguishes patentably over the references of record.

Claim 6 calls for the wire feeder of claim 3 to include a fixed ratio gear reducer between the motor and the feed rolls. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 6 distinguishes patentably over the references of record.

Claim 7 calls for the wire feeder of claim 2 to include a fixed ratio gear reducer between the motor and the feed rolls. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 7 distinguishes patentably over the references of record.

Claim 8 calls for the wire feeder of claim 1 to include a fixed ratio gear reducer between the motor and the feed rolls. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 8 distinguishes patentably over the references of record.

Claim 9 calls for the switching circuit of claim 8 when in the condition to select the second brush to have a time delay for selecting the third brush for a time before selecting the second brush. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 9 distinguishes patentably over the references of record.

Claim 10 calls for the switching circuit of claim 3 when in the condition to select the second brush to have a time delay for selecting the third brush for a time before selecting the second brush. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 10 distinguishes patentably over the references of record.

Claim 11 calls for the switching circuit of claim 2 when in the condition to select the second brush to have a time delay for selecting the third brush for a time before selecting the second brush. Applicant does not find this limitation in either of the

applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 11 distinguishes patentably over the references of record.

Claim 12 calls for the switching circuit of claim 1 when in the condition to select the second brush to have a time delay for selecting the third brush for a time before selecting the second brush. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 12 distinguishes patentably over the references of record.

Claim 13 calls for the wire feeder of claim 12 to include a circuit to latch the switch circuit in the operative condition when power is received by the leads. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 13 distinguishes patentably over the references of record.

Claim 14 calls for the wire feeder of claim 8 to include a circuit to latch the switch circuit in the operative condition when power is received by the leads. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 14 distinguishes patentably over the references of record.

Claim 15 calls for the wire feeder of claim 3 to include a circuit to latch the switch circuit in the operative condition when power is received by the leads. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 15 distinguishes patentably over the references of record.

Claim 16 calls for the wire feeder of claim 2 to include a circuit to latch the switch circuit in the operative condition when power is received by the leads. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 16 distinguishes patentably over the references of record.

Claim 17 calls for the wire feeder of claim 1 to include a circuit to latch the switch circuit in the operative condition when power is received by the leads. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 17 distinguishes patentably over the references of record.

Independent claim 18 calls for a wire feeder for an electric arc welder to comprise a set of feed rolls driven by a motor and a switching condition to change the speed of said motor between a first and second speed. Applicant does not find all these limitations in either of the applied references. Moreover, the Examiner has not pointed out with specificity where these limitations are disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 18 distinguishes patentably over the references of record.

Claim 19 calls for the switch circuit in the wire feeder of claim 18 to be operated manually. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 19 distinguishes patentably over the references of record.

Claim 20 calls for the wire feeder in claim 19 wherein when said switching circuit selects the first speed a circuit selects the second speed for a time to accelerate the feed rolls for the time. Applicant does not find this limitation in either of the applied references. Moreover, the Examiner has not pointed out with specificity where this limitation is disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 20 distinguishes patentably over the references of record.

Independent claim 21 calls for a D.C. motor driving a wire feeder of an electric arc welder. The D.C. motor has a commutator. First and second opposite polarity leads receive power to drive the motor. A first brush is at a given position on the commutator and connected to the first lead. A second brush is circumferentially spaced from the first brush a first annular distance around the commutator and connectable to the second lead to cause the motor to rotate at a first speed and a third brush is circumferentially spaced from the first brush a second annular distance around the commutator and connectable to the second lead to cause the motor to rotate at a second speed. Applicant does not find all these limitations in either of the applied

references. Moreover, the Examiner has not pointed out with specificity where these limitations are disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 21 distinguishes patentably over the references of record.

Independent claim 22 calls for a wire feeder for an electric arc welder to comprise a set of feed rolls driven by a D.C motor with a commutator. First and second opposite polarity leads receive power to drive the motor and have a first brush at a given position on the commutator and connected to the first lead and a second brush circumferentially spaced from the first brush an annular distance around the commutator and connected to the second lead and a device to change the annular distance to change the speed of the motor driving the feed rolls. Applicant does not find all these limitations in either of the applied references. Moreover, the Examiner has not pointed out with specificity where these limitations are disclosed or fairly suggested in the applied references. For this reason, Applicant submits that claim 22 distinguishes patentably over the references of record.

CONCLUSION

All formal and informal matters having been addressed, it is respectfully submitted that this application is in condition for allowance. Alternatively, if the Examiner is of the view that the application is not in clear condition for allowance, it is requested that the Examiner telephone the undersigned for purposes of conducting a telephone interview to resolve any outstanding differences. Accordingly, an early notice of allowance is earnestly solicited.

Respectfully submitted,

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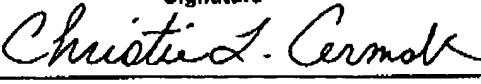
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